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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/002,880	11/02/2001	Jeffrey T. Eschbach	68696	4826

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FITCH EVEN TABIN AND FLANNERY
120 SOUTH LA SALLE STREET
SUITE 1600
CHICAGO, IL 60603-3406

EXAMINER	
SON, LINH L D	

ART UNIT	PAPER NUMBER
2135	

DATE MAILED: 07/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/002,880	ESCHBACH ET AL	
	Examiner	Art Unit	
	Linh Son	2135	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 November 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-27* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This written action is responding to the Application filed on November 2nd, 2001.

2. Claims 1-27 are pending.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 20-21, and 24-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Wada et al, US Patent No. 5517618, hereinafter "Wada".

5. As per claims 20-21, 24-26, and 27. Wada discloses "A method for transferring a communication session in an IP network from a first node to a second node via use of an IP address without disrupting the communication session, the method comprising: initiating a communication session request between a first node and a Correspondent Node using base IP addresses for the nodes" in (Col 11 lines 30-34, and Col 11 line 60 to Col 12 line 20); "generating a communication session specific IP address with which the communication session will be associated; initiating a communication session between the first node and the Correspondent Node using the session specific IP address" in (Col 15 line 65 to Col 16 line 16); "negotiating a transfer of the session

specific IP address from the first node to a second node such that the second node will generally assume communicating with the Correspondent Node" in (Col 16 lines 25-55); "generating a Proxy ARP message to bind a link-layer address associated with the second node's to the session specific IP address so that the second node can intercept the communications pertaining to the session specific IP address" in (Col 16 lines 25-55); and "intercepting the communications addressed to the session specific IP address via the second node such that the communication session with the Correspondent Node continues without interruption" in (Col 16 line 55 to Col 17 line 10, and Col 30 lines 20-35).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 1-2, 5, 9-10, 12, 14-17, 19 and 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wada.

8. As per claims 1-2, 9, 12, 17, and 22, Wada discloses "A method of seamlessly transferring a communication session on an IP network, the method comprising:

initiating a communication session between a correspondent device and a first device using a session specific IP address as the first device IP address" in (Col 11 lines 30-34, and Col 11 line 60 to Col 12 line 20); "negotiating to transfer the communication session from the first device to a second device" in (Col 12 lines 23-45); and "transferring the first device IP address from the first device to the second device IP address so that communication session data transferred from the correspondent device to the first device via the address thereof will be received by the second device" in (Col 13 line 65 to Col 14 line 65). However, Wada is silent on transfer the first device IP address to the second device. Nevertheless, Wada does teach a process of migrating a the TCP session from the first network to the second network, which is obvious that the same ip address can not used. Further, the transfer process is including transfer the TCP session to a temporary address and then transfer to the destination second address. Therefore, it would have been obvious at the time of the invention was made for one having ordinary skill in the art to realize that the same IP address can be transferred from the first device to the second device only in the same network by utilize another temporary address until the first IP address gets re-ARP-ed to the second device in (Col 30 lines 23-45).

9. As per claim 5, Wada discloses "A method according to claim 1". However, Wada is silent on "the method further comprises: generating a wake-up message once the communication session is no longer to be transferred causing the first device to resume receiving communication sessions addressed to its IP address". Nevertheless,

it would have been obvious at the time of the invention was made for one having ordinary skill in the art to realize that the temporary communication session can also be done for only a period of time and then repeat the same communication session transferring process back to its origination (Col 30 lines 23-45).

10. As per claim 14, Wada discloses "A method according to claim 9, wherein the method further comprises: notifying the second device of any information that is needed to maintain use of the session specific IP address so that the session specific IP address will continue to work throughout the session transfer" in (Col 30 lines 23-45).

11. As per claim 15, the rejection basis of claim 1 is incorporated. Further, Wada discloses "A method according to claim 9, wherein the first device and second device are on the same subnet and the method further comprises: intercepting the session addressed to the first device at the session specific IP address via the second device" in (Col 30 lines 23-45).

12. As per claim 16, Wada discloses "A method according to claim 15, wherein the interception of the session comprises: using a Proxy ARP message to bind a link-layer address associated with the second device to the session specific IP address" in (Col 11 lines 30-45, and Col 12 lines 30-60).

13. As per claims 10, 19 and 23, the rejection basis in claim 1 is incorporated. Further, Wada discloses "A method according to claims 1, 9 and 21, wherein the method further comprises: releasing the session specific IP address once the session has ended so that the address can be reused for future sessions" in (Col 30 lines 23-45).

14. Claims 3-4, 6-8, 11, 13, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wada in view of Knight et al, US Patent No. 6377589B1, hereinafter "Knight".

15. As per claims 3-4, 6, 11, 13, 18, Wada discloses "A method according to claims 2, 9, 11, and further teaches a method of transfer the encrypted session and also authenticating the session" in (Col 33 lines 17-28). However, Wada is silent on "the created method for securely transferring the communication session comprises: generating a random number to serve as a session key for the secure transfer of the communication session between the first device and the second device". Nevertheless, Patel discloses the "Communication System" invention which includes a method of communicating a secure and encrypted conversation using a random number as a session key in (Col 5 lines 1-10, and Col 8 lines 34-50). Therefore, it would have been obvious at the time of the invention was made for one having ordinary skill in the art to

modify Wada's invention to incorporate Patel's method to provide a secure transferring session.

16. As per claim 7, Wada discloses "A method according to claim 6, wherein the method further comprises: authenticating the notice from the first device to the Agent to ensure that the first device is the source of the notice" in (Col 33 lines 40-45).

17. As per claim 8, Wada discloses "A method according to claim 6, wherein the method further comprises: notifying the Agent whether the second device is authorized to transfer the session" in (Col 33 lines 40-45).

Double Patenting

18. The non-statutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

19. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

20. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

21. Claims 1-27 of the instants application No. 10002880, hereinafter '880, are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of copending Application No. 10002306, hereinafter '306. Although the conflicting claims are not identical, they are not patentably distinct from each other because as follow:

22. The instants application '880:

Exemplary Claims 1 and 9 recite:

> **(1)** A method of seamlessly transferring a communication session on an IP network, the method comprising:
>
> **(2)** initiating a communication session between a correspondent device and a first device using a session specific IP address as the first device IP address;

(3) negotiating to transfer the communication session from the first device to a second device;

(4) and transferring the first device IP address from the first device to the second device so that communication session data transferred from the correspondent device to the first device via the address thereof will be received by the second device.

23. The copending application '306:

Exemplary Claims 1 and 9 recite:

Claim 1 recites:

(1) A method of seamlessly transferring a communication session on an IP network from a first device to a second device, the method comprising:

(2) initiating a session between a correspondent device and a first device having a first device IP address;

(3) negotiating to transfer the session from the first device to a second device;

(4) and transferring the first device IP address away from the first device to another device so that data transferred from the correspondent device to the first device via the address thereof will be received by the second device

24. As underlined above, the limitations **(1)** and **(4)** of both applications recite the exact language.

However, the limitations **(2),** and **(3)** in '880 recites the "session" and the limitations **(2),** and **(3)** in '306 recites the "communication session". It is clearly that the language in '880 is more specific than in '306. Therefore, the exemplary claims 1 and 9 in '880 is clearly anticipate in claim 1 and 9 in '880.

25. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

26. "Claim 1 and 9 in '880 are generic to the species of claims 1 and 9 in '306. Thus, the generic invention is "anticipated" by the species of the copending application invention. Cf., Titanium Metals Corp. v. Banner, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985) (holding that an earlier species disclosure in the prior art defeats any generic claim). This court's predecessor has held that, without a terminal disclaimer, the species claims preclude issuance of the generic application. In re Van Ornum, 686 F.2d 937, 944, 214 USPQ 761, 767 (CCPA 1982); Schneller, 397 F.2d at 354. Accordingly, absent a terminal disclaimer, claims 12 and 13 were properly rejected under the doctrine of obviousness-type double patenting."

(In re Goodman (CA FC) 29 USPQ2d 2010 (12/3/1993).

27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Linh LD Son whose telephone number is 571-272-3856. The examiner can normally be reached on 9-6 (M-F).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Linh LD Son
Patent Examiner

KIM VU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100